

AMENDMENTS TO THE DRAWINGS

The attached sheet of drawings includes new FIG. 15.

Attachment: Replacement Sheet

REMARKS

Reconsideration and allowance in view of the foregoing amendments and the following remarks are respectfully requested.

Claims 39-48 remain pending in the present application.

Applicant notes with appreciation the Examiner's indication that claims 39-43 are allowed, and that claims 46-48 would be allowable if rewritten in independent form and the rejection of claim 48 as being indefinite is overcome.

The specification has been amended above to include the patent number of the parent application in the priority claim, to list new FIG. 15 in the Brief Description of the Drawings section, and to include a reference to new FIG. 15 in the body of the specification. No new matter has been added as discussed below. Accordingly, applicant respectfully requests that the amendments to the specification be approved.

The drawings stand object to under 35 U.S.C. § 1.83(a) has failing to show every feature specified in the claims. According to the Examiner, the passive probe and external controller are not shown in the drawings. Applicant respectfully disagrees. The passive probe is illustrated schematically in FIG. 12 as items 160 and 162. It should be noted that these items also correspond to the intramuscular stimulators. However, page 40, lines 13-15, of the specification indicates that the present invention contemplates replacing such active probes with passive probes. Thus, the illustration of the active probe as items 160 and 162 in FIG. 12 also serves to illustrate the passive probes.

Be that as it may, new FIG. 15 has been added to illustrate an example of passive probe. No new matter has been added as the probe illustrated in this figure was described in the specification, as filed, at page 40, lines 15-18. Accordingly, applicant respectfully requests that the new FIG. 15 be approved.

The external controller used to control the passive probe is the same controller used to active stimulator, because, as noted above, the passive probes can be substituted for the active stimulators. Thus control unit 32, which is shown in FIG. 1, can be used as the control unit for providing energy to the passive probe.

For the reasons presented above, applicant submits that every limitation recited in the pending claims is shown in the drawings. Accordingly, applicant respectfully requests that the objection to the drawings be withdrawn.

Claim 48 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. More specifically, the Examiner questions whether the second passive probe recited in this claims performs the same function as the first passive probe. It does. Claim 48 is provided to clarify that more than one passive probe can be implanted in the user. Claims 44, 45, and 48 have been amended to clarify further that the first target tissue where the first passive probe need not necessarily be the exact same location as the second target tissue where the second passive probed is located in the user. Accordingly, applicant respectfully requests that the above rejection of claim 48 be withdrawn.

Claims 44 and 45 stand rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 4,340,038 to McKean ("the '038 patent"). Applicant respectfully traverses this rejection for the reasons presented below.

The '038 patent discloses the use of a metallic slug 28 to focus the flux density of a magnetic field generator to an implanted device 14 that requires power to operate. Claim 44, however, recites that the first passive probe is positioned within a first target tissue that corresponds to a location in such a patient where applying an electrical stimulation to such a patient serves to stabilize an upper airway. In addition, claim 44 recites that the passive probe is configured and arranged to alter a characteristic of the magnetic field to enhance a stimulation of the target tissue by the magnetic field. Thus, claim 44 uses the passive probe alone to enhance stimulation of the target tissue for the purposes of opening the airway. The Examiner appears to have failed to appreciate all of this language found in claim 44.

Slug 28 in the '038 patent is not implanted in a region that accomplishes this purpose. In addition, nothing in the '038 patent teaches or suggests that the slug by itself be used to stimulate the tissue of the patient. Slug 28 is merely a flux density focusing element, not a stimulation inducing element. Accordingly, applicant respectfully submits that one of ordinary skill in the art would not consider it obvious to use slug 28 as a passive probe as recited in independent claim 44.

The Examiner recognizes that slug 28 is not used in the '038 patent in the manner or location of that of the present invention. To this point, the Examiner notes on the last line of page 3 of the June 20, 2007 Office Action in rejecting claim 45 that slug 28 is capable of being implanted in this area of the patient set forth in claim 45. Applicant first points out, in response to this conclusion, that even if slug 28 is used in the region set forth in claim 44 or 45, which applicant does not concede would be obvious to one of ordinary skill in the art, nothing in the '038 patent teaches or suggests using the slug as the means for stimulating the tissue. At best, the '038 patent teaches using the slug in combination with another element to provide power to that other element. This patent does not suggest to one of ordinary skill in the art to omit the second device, such as the ICPM, and use the slug as the tissue stimulator.

That the prior art device is "capable of" being implanted in the area recited in the claim or performing the intended use does not render the claim obvious. There must be some reason, common sense or otherwise, why one of ordinary skill in the art would be motivated to use the slug of the '038 patent in the upper airway in the recited manner. Applicant respectfully submits that such motivation is lacking from the cited reference. Instead, the Examiner appears to be relying on an improper hindsight review of the '035 patent based on the teachings of the present invention to decide that slug 28 could be used in the manner recited in the claims.

Applicant also would like to point out that the functional or intended use language in claim 44 should not be ignored. It is well established that it is entirely proper to define an invention in functional terms. *See, e.g., In re Swinehart*, 439 F.2d 210, 169 U.S.P.Q. 226 (C.C.P.A. 1971). For example, claim 44 recites "a first passive probe adapted to be positioned within a first target tissue of a patient, wherein the first target tissue corresponds to a location in such a patient where applying an electrical stimulation to such a patient serves to stabilize an upper airway of such a patient without assistance of an implanted device that mechanically suspends of tissues associated with the upper airway". This form of claim language is specifically chosen so as not to limit the invention to a specific configuration for the passive probe. The specification discloses a strip like probe that can be wrapped around a nerve. However, other configurations are contemplated and are intended to be encompassed by the language of the claim.

That the applicant chooses to cast the claim in this form does not mean that the functional language can be ignored. It is impermissible for the Patent Office to refuse to provide patentable weight to functional limitations. *See, e.g., In re Land*, 151 U.S.P.Q. 621 (C.C.P.A. 1966) in which the court held that portions of a disputed claim were functional, but nevertheless held the claim patentable over the prior art in view of the functional limitations. The Patent Office must afford patentable weight to functional limitations even if the functional limitations are the only limitations that are nonobvious over the prior art. *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). *See also In re Atwood*, 148 U.S.P.Q. 203,210 (C.C.P.A.. 1966)(“[w]e have here a combination claims and the limitations ignored by the board as use limitations we think are functional expressions which must be given weight”); *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); *In re Zurko*, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir.), *reh’g en banc granted*, 116 F.3d 874 (Fed. Cir. 1997).

Applicant also calls to the Examiner’s attention M.P.E.P. § 2173.05(g). This section expressly authorizes the use of functional language and specifically acknowledges that “[a] functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it conveys to a person of ordinary skill in the pertinent art in the context in which it is used.”

For the reasons presented above, applicant respectfully submits that independent claim 44 is not anticipated or rendered obvious by the cited references. In addition, claim 45 is also not anticipated or rendered obvious due to their dependency from independent claim 44. Accordingly, applicant respectfully requests that the above rejection of claims 44 and 45 be withdrawn.

This response is being filed within the three-month statutory response period which expires on September 20, 2007. In addition, no additional claim fees are believed to be required as a result of the above amendments to the claims. Nevertheless, the Commissioner is authorized to charge any fee required under 37 C.F.R. §§ 1.16 or 1.17 to deposit account no. 50-0558.

MECHLENBURG et al. -- Appln. No.: 10/811,592

All objections and rejections have been addressed. It is respectfully submitted that the present application is in condition for allowance and a Notice to the effect is earnestly solicited.

Respectfully submitted,

By Michael W. Haas
Michael W. Haas
Reg. No.: 35,174
Tel. No.: (724) 387-5026
Fax No.: (724) 387-5021

RESPIRONICS, INC.
1010 Murry Ridge Lane
Murrysville, PA 15668-8525

Attached: New FIG. 15.

Note: The Commissioner is authorized to charge any fee required under 37 C.F.R. §§ 1.16 or 1.17 to deposit account no. 50-0558.